

III. REMARKS

The claims have been amended to better conform to U.S. practice.

Claims 1-8, 13-23, 27-32, 34, and 38 are not unpatentable under 35 U.S.C. 103(a) over Smith in view of Bulfer and Biliris.

The invention of Claim 1 relates to erasing stored notification messages from a terminal memory in response to a specific procedure relating to contacting a specific address. This avoids unnecessary filling of the terminal memory and thereby requiring the user to delete messages.

Bulfer is for the problem of avoiding polling of many messaging services (see col. 1, lines 36-45). Polling is a different problem than the deletion problem solved by the claimed invention, and it cannot be properly combined with Smith (see *In re Bigio*, 72 USPQ2d 1209, 1212 and MPEP 2143.01).

There is also legal motivation to combine Bulfer with Smith. The Examiner states that the combination is obvious in order to "better assure that a subscriber of a cellular network receives all waiting messages." However, the Examiner has not provided any reason why one would look to combine these references to address the same or similar problems as the Applicant seeks to address. (Pro-Mold & Tool Co. v- Great Lakes Plastics, Inc., 37 USPQ2d 1636, 1630) (Fed. Cir. 1996). Since the Examiner has not provided any showing why one who is seeking to solve the problem addressed by Applicant would look to combine these two references legal motivation for purposes of 35 G.S.C. §103(a) cannot be established. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

More importantly, as the Examiner correctly states on page 3 of the last Office Action, the combination of Smith & Bulfer does not teach erasing the notification message from the memory of the terminal. The Examiner cites Biliris for this feature.

Biliris is for the problem of a message recipient paying for messages (see col. 1, lines 17 to 28). Since this is different from the deletion problem solved by the claimed invention, it cannot be properly combined with Smith & Bulger.

The Examiner refers to Biliris as teaching erasing of the notifications as claimed. However, Biliris discloses that if the terminal does not use a received notification to fetch a message, the message is not delivered and responsively the server disposes the message (step 210, see col. 3, lines 49-55). Biliris discloses that the terminal may ignore the notification. Ignoring is not paying attention. Not taking active measures is not the same as deleting the notification. It is respectfully submitted that the Examiner neglects that, while Biliris in col. 3 lines 54–55, mentions deleting a notification message, Biliris fails to disclose automatic deleting, not to mention erasing a notification in response to a specific procedure relating to contacting the specific address as presently claimed. Even if deleting happened automatically, deleting is disclosed in a context in which the terminal does not contact any specific address and in which the message is not delivered to the terminal.

There is also no motivation to combine Biliris with Smith and Bulger for similar reasons as those stated above.

Thus, even if the above references are combined, the result is not the invention of Claim 1. Claims 16 and 30 similar limitations, hence the rejection of Claims 1-8, 13-23, 27-32, 34-38 should be withdrawn.

Claims 9-12, 24-26, and 33 are not unpatent under 35 U.S.C. 103(a) over Smith, Bulfer and Biliris, and further in view of Kaisto.

Kaisto is for the problem of informing every subscribe of a waiting voice mail message. Since this is different from the deletion problem solved by the claimed invention, Kaisto cannot be properly combined with the previous references. Further, since it fails to disclose the above-discussed erasing limitation, even if it is somehow combined, the result is not the claimed invention. There is also no motivation to combine Kaisto with the cited references.

Thus, the rejection of Claims 9-12, 24-26 and 33 should be withdrawn.

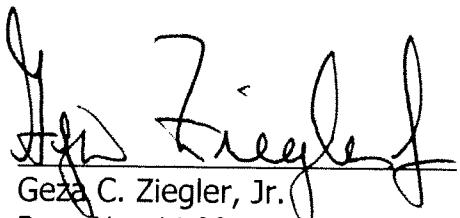
For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

09/696,646

Response to the Office Action date 25 January 2007

Respectfully submitted,


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25 April 2007
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